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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,143	06/21/2005	Makoto Katsumata	050396	3589

23850 7590 03/06/2008

KRATZ, QUINTOS & HANSON, LLP
1420 K Street, N.W.
Suite 400
WASHINGTON, DC 20005

EXAMINER	
MAYO III, WILLIAM H	

ART UNIT	PAPER NUMBER
2831	

MAIL DATE	DELIVERY MODE
03/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/540,143	KATSUMATA ET AL.	
	Examiner	Art Unit	
	William H. Mayo III	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 & 4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 16, 2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al (JP Pat Num 06-190315, herein referred to as Masuda) in view of Kondo (JP Pat Num 10-031918). Masuda discloses an electrical cable (Figs 1-11) having a conductor core (3) and a sheathing layer (not number) covering the core (3), wherein the sheathing layer (not numbered) is made by a synthetic material having an outer surface with a mono color (paragraph 7), wherein the freedom of marking and lay out of the cable can be improved (see abstract under purpose). Specifically, with respect to claim 1, Masuda discloses an electrical cable (Figs 9 & 11) comprising a first mark (M1) having a first color and provided on a first outer surface portion (left end) of an outer surface of the sheathing layer (not numbered), and a second mark (M2) having a second color (paragraph 9) and provided on a second outer surface portion (right end) of the outer surface of the sheathing layer (not numbered), wherein the second color is provided by an ink feeder (10_2) that is a different from a first color which is provided by a second ink feeder (10_1, paragraph 9), wherein the second outer surface portion (right

end) is positioned on a opposite side of the first side (left end) in a lateral direction of the cable (Fig 9), wherein the first mark (M1) different than the second mark (M2) in a longitudinal direction of the cable (Fig 9b) so as to be opposite to each other in relation to an axial center of the cable (Fig 9b), wherein the sheathing layer (not shown) of the cable (6) has first and second outer surface portions (outer surface of the right and left ends, respectively), each extending in a longitudinal direction of the cable (Fig 12), wherein the first and second outer surfaces (outer surfaces of the left and right ends) may be provided with a plurality of first and second marks (Ma & Mb & Mc) that are alternately positioned (Fig 11 & 12) in a longitudinal direction (Fig 12), wherein the first mark (Ma) and the second mark (Mc) are positioned at an end of the cable (Figs 11 & 12, Page 2 of Detailed Description, paragraph 9) so as to be positioned opposite each other in relation to an axial center of the cable (as shown in Figure 11; markings are on the top and bottom surface portions as well as on opposite ends). With respect to claim 4, Masuda discloses that the sheathing layer (not numbered) of the cable (Fig 11) has a first outer surface (outer surface of the left end) and a second outer surface (outer surface of right end), wherein the first and second outer surface (outer surface of the right and left ends, respectively), each extending in a longitudinal direction of the cable (Fig 12), wherein the first outer surface (outer surface of the left end) is positioned oppositely to the second outer surface (outer surface of the right end) in a circumferential direction of the cable (Fig 11) with regular intervals (Fig 9b & 11, both shown the ink deposit nozzles being on opposite sides with respect to a circumferential direction) and wherein at least three of the first and second marks (Ma, Mb, & Mc) are

provided at the end of the cable in a circumferential direction of the cable with regular intervals (Figs 11 & 12).

However, Masuda doesn't necessarily disclose the first mark being longer than the second mark (claim 1).

Kondo teaches an electrical cable (Figs 1-15) having a conductor core (10) and a sheathing layer (12) covering the core (10), wherein the sheathing layer (12) is made by a synthetic material having an outer surface with a mono color (See Means for Solving the Problem, paragraph 20), wherein the freedom of marking and lay out of the cable can be improved (see abstract under solution). Specifically, with respect to claim 1, Kondo teaches an electrical cable (Fig 12) comprising a first mark (83) having a first color and provided on a first part (left end) of an outer surface of the sheathing layer (12), and a second mark (right side of cable, 82) having a second color (see Means for Solving the Problem, paragraph 26) and provided on a second part (right end) of the outer surface of the sheathing layer (12), wherein the second color is provided by an ink feeder (18) that is a different from a first color which is provided by a second ink feeder (20, see Means for Solving the Problem, paragraph 26), wherein the second part (right end) is positioned on a opposite side of the first side (left end) in a lateral direction of the cable (Fig 12), wherein the first mark (left side of cable indicated by 83) is longer than the second mark (right side of cable, 82) in a longitudinal direction of the cable (Fig 12, see Means for Solving the Problem, paragraph 37), wherein the first mark (left end, 83) and the second mark (right end, 82) are positioned at an end of the cable (Fig 12).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the insulated wire of Masuda to comprise the first and second mark configuration as taught by Kondo because Kondo teaches that such a configuration provides the freedom of marking and lay out of the cable can be improved (see abstract under solution), thereby raising production efficiency (Paragraph 41).

Response to Arguments

6. Applicant's arguments filed January 16, 2007 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:

A) Masada's drawings of FIGS. 9 and 11 do not show or suggest the claimed "at least one of the first and second outer surface portions being provided with a plurality of the first and second marks that are alternatively positioned in the longitudinal direction of the cable", as required in Claim 1.

With respect to argument A, the examiner respectfully traverses. Firstly, Masuda clearly the first and second outer surfaces (outer surfaces of the left and right ends) may be provided with a plurality of first and second marks (Ma & Mb & Mc) that are alternately positioned (Fig 11 & 12) in a longitudinal direction (Fig 12), wherein the first mark (Ma) and the second mark (Mc) are positioned at an end of the cable (Figs 11 & 12, Page 2 of Detailed Description, paragraph 9) so as to be positioned opposite each other in relation to an axial center of the cable (as shown in Figure 11; markings are on

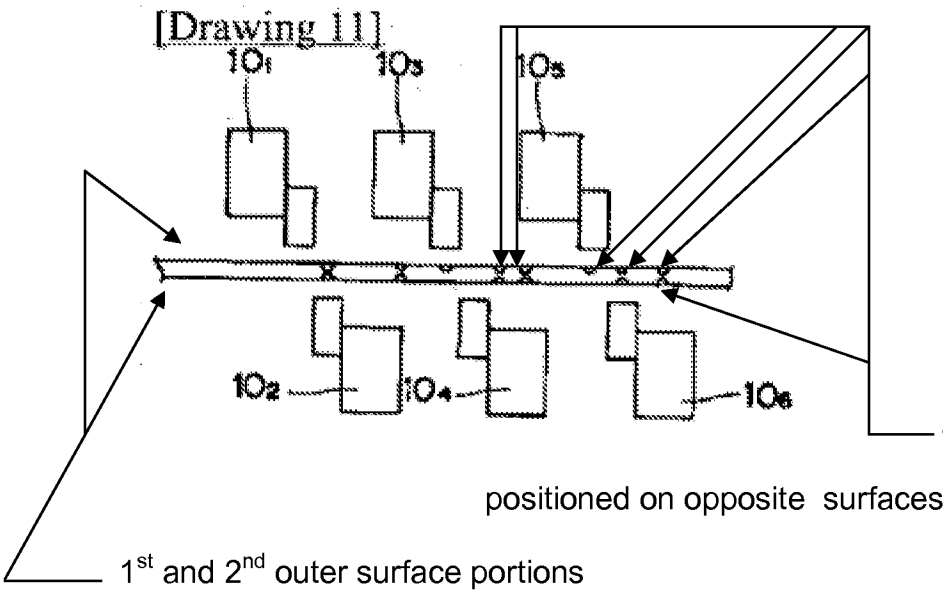
the top and bottom surface portions as well as on opposite ends). Specifically, Masuda states the following with respect to Figures 11 & 12.

> [0009] Moreover, since the band mark of the color from which plurality differs is given and the combination of the color of this band mark expresses information, such as a size of the core wire of an electric wire, and insulating strength, as it is shown in drawing 11 , it is electric-wire band marking equipment 101 of a pair. And 102 Otherwise, it is two electric-wire bands marking equipment 103. 104 And 105 And 106 There are some which it has. With this equipment, it can give combining the band mark of 2-3 kinds of colors, using three electric-wire bands marking equipment alternatively. In addition, drawing 12 shows the electric wire 6 which repeated and gave the band marks Ma, Mb, and Mc of three colors with the equipment of drawing 11 .

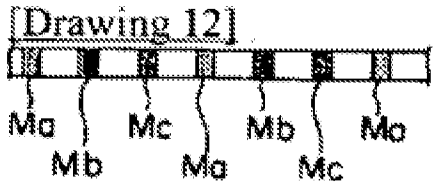
Secondly, it must be stated it has been held that the drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. In re Aslanian, 590 F. 2d 911, 200 USPQ 500 (CCPA 1979). Secondly, the MPEP states:

> **2125 Drawings as Prior Art**
>
> DRAWINGS CAN BE USED AS PRIOR ART
>
> Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. In re Mraz, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). However, the picture must show all the claimed structural features and how they are put together.Jockmus v. Leviton, 28 F.2d 812 (2d Cir. 1928). The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification.

Masuda clearly illustrates in Figure 11 a plurality of nozzles ($10_{1\text{-}6}$) for providing a plurality of markings (not numbered in Figure 11, however as shown in Figure 12) having three distinct colors, which are alternatively repeated along the length of the cable (see paragraph 9 provided for reference above). Specifically, Masuda illustrates



While the marks are not denoted, Masuda clearly states in the description (see paragraph 12) that the markings illustrated in Figure 11 are the markings denoted as Ma, Mb, & Mc in Figure 12. Figure 11 clearly shows that the markings are inked along the length of the cable on a first and second outer surface portion (i.e. top and bottom surface portions). Figure 12 clearly shows a plurality of three different markings that are utilized with the ink nozzles ((10_{1-6}) of Figure 11 (see paragraph 9 above).



Masuda also refers to the electrical wire (6 as denoted in Figures 9a-b) when referring to the wire in Figures 11 & 12 (see paragraph 9 above).

Therefore, Masuda clearly teaches the first and second outer surfaces (outer surfaces of the left and right ends) may be provided with a plurality of first and second marks (Ma & Mb & Mc) that are alternately positioned (Fig 11 & 12) in a longitudinal direction (Fig 12), wherein the first mark (Ma) and the second mark (Mc) are positioned at an end of the cable (Figs 11 & 12, Page 2 of Detailed Description, paragraph 9). In light of the above stated comments, the examiner respectfully submits that the 35 USC 103(a) rejection is proper and just.

Conclusion

7. **THIS ACTION IS MADE NON-FINAL.** A shortened statutory period for reply to this non-final action is set to expire THREE MONTHS from the mailing date of this action.

Communication

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245 or (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Mayo III/

William H. Mayo III
Primary Examiner
Art Unit 2831

WHM III
February 28, 2008